



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,472	03/15/2001	Rajendra Kumar	KHY.P.US0052	2521

7590 01/18/2005
Scott M Oldham
HAHN LOESER PARKS
1225 W Market Street
Akron, OH 44313

EXAMINER

HARTMAN JR, RONALD D

ART UNIT	PAPER NUMBER
----------	--------------

2121

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,472

Applicant(s)

KUMAR, RAJENDRA

Examiner

Ronald D Hartman Jr.

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-22 is/are allowed.
- 6) ☒ Claim(s) 1-10 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the Amendment filed on 11/4/2004.
2. Claims 1-27 are presented wherein claim 27 is newly added.
3. Claim 27 has been withdrawn by the examiner, see below.

Election/Restrictions

4. Newly submitted claim 27 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

As per claim 27, the inclusion of newly added features that were not present in any previously claims provides the basis for this election by original presentation. These newly added features are a first and second rechargeable power source, wherein one power source is located in the handset unit and the other power source is located in the hand held unit. These features were not previously claimed and none of the other independent claims set forth these features. A simple comparison of at least claims 16 and 27 will show features in each claim that are not present in the other. As per claims 16 and 27, claim 16 claims a handheld device that calls for a card shaped peripheral to be used for communications, whereas claim 27 claims a handheld device that calls for a first and second rechargeable power source wherein one power source is located in the handset unit and the other is located in the handheld unit. These differing claims present claims that are both subcombinations useable together in the same combination, wherein the combination is broadly represented by pending claim 1.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 27 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2121

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 23-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 1 and 23, a feature wherein communications between the handset unit and the handheld unit occurs wirelessly when the two units are docked is not a feature that is adequately described or contemplated by the disclosure as originally filed.

There appears to be adequate support for wireless communications when the units are not docked, but there does not appear to be adequate support for wireless communications when the units are docked since when the units are docked, it appears that the units would communicate with each other by utilizing elements 23 and 36 of Figure 7. Since these feature were presented after an office action on the merits, these features are believed to constitute "new matter".

Allowable Subject Matter

6. Claims 1-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action above, and this is further explained below.

As per claims 1-10, specifically independent claim 1, the prior art of record fails to teach the handheld device which is formed by connecting or attaching a handset unit with a handheld unit so as to form a single communication device, wherein the handheld unit possesses a voice driven interface and wherein the formed communication device is useable and held by one hand and wherein the two units may communicate with one

Art Unit: 2121

another using wireless communications when the units are undocked, in combination with the other claimed features and or limitations as claimed.

As per claims 11-15, specifically independent claim 11, the prior art of record fails to teach the handheld device which is formed by connecting or attaching a handset unit with a handheld unit so as to form a single communication device, wherein the formed communication device is useable and held by one hand and wherein the two units may communicate with one another using wireless communications when the units are undocked, in combination with the other claimed features and or limitations as claimed.

As per claims 16-22, specifically independent claim 16, the prior art of record fails to teach the handheld device which is formed by connecting or attaching a handset unit with a handheld unit so as to form a single communication device, wherein the formed communication device is useable and held by one hand and wherein the two units may communicate with one another using wireless communications when the units are undocked, and wherein a card shaped peripheral is provided by utilizing a slot in the handheld unit so that communications between the handheld unit and the handset may occur, in combination with the other claimed features and or limitations as claimed.

As per claims 23-26, specifically independent claim 23, the prior art of record fails to teach the handheld device which is formed by connecting or attaching a handset unit with a handheld unit so as to form a single communication device, wherein the formed communication device is useable and held by one hand and wherein the two units may communicate with one another using wireless communications when the units are undocked, in combination with the other claimed features and or limitations as claimed.

7. The closest available prior art was issued to Laureanti, U.S. Patent No. 6,188,917, in which a system similar to the system currently claimed is disclosed.

Laureanti discloses a system wherein a PDA may be interfaced with a cellular telephone for data accessing purposes. This system does not teach a voice driven

interface being utilized by the handheld unit (PDA), nor does this system disclose utilizing wireless communications when the handset unit and the handheld unit are not docked together.

Laureanti's disclosed system uses the cellular phone to communicate with a remote location whereas the pending claimed invention utilizes the handheld unit (PDA) for this communication. In other words, the communications of the pending claims is inverted to that disclosed by Laureanti, and this difference coupled with the aforementioned deficiencies and/or believed novel features of the pending claimed invention form the basis for indicating the allowable subject matter listed above, with respect to claims 1-16.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is 703-308-7001, and after October 12, 2004, (571) 272 - 3684. The examiner can normally be reached on Mon. - Fri., 11:30 am - 8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179, and starting October 12, 2004, at (571) 272 - 3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2121

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald D Hartman Jr.

Patent Examiner; Art Unit 2121

X RDH



Anthony Knight
Supervisory Patent Examiner
Group 3600